

REMARKS/ARGUMENTS

Claim 57 is pending in the present application. Claims 1-57 have been canceled. Claims 58 and 59 are added. Applicants are not conceding in this application the subject matter removed from canceled claims 1-57 are not patentable over the art cited by the Examiner. The present claim amendments and cancelations are only for facilitating expeditious prosecution of the application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claim 57 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Office Action pp. 3-4. This rejection is respectfully traversed.

Claim 57 has been canceled, and the rejection is moot. Therefore, the objection of the specification under 35 U.S.C. § 112, first paragraph has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claim 57 under 35 U.S.C. 103(a) as being unpatentable over Fullerton et al. U.S. Publication No. 2001/0033296 A1 (hereinafter Fullerton), in view of Dieberger et al. U.S. Publication No. 2003/0122863 A1 (hereinafter Dieberger), Microsoft PowerPoint 2000 (screen printout pages 1-14 demonstrating a step by step guide showing some of the features of PowerPoint Page 4 2000), Yacovone et al. U.S. Publication No. 2002/0109712 A1 (hereinafter Yacovone), Lee et al. U.S. Publication No. 2003/0218639 A1 (hereinafter Lee), Gardner et al. U.S. Publication No. 2005/0076312 A1 (hereinafter Gardner), and Banning U.S. Patent No. 6,380,957 B1 (hereinafter Banning). Office Action pp. 4-9. This rejection is respectfully traversed.

A. Support for new claims 58 and 59

Support for new claims 58 and 59 is found in the specification and drawings as follows:

A computer implemented method for adding an intelligent agenda to a first plurality of slides in presentation program stored in a memory connected to a computer, the computer implemented method comprising:	FIG. 1; FIG. 2, 300, 500
loading a configuration program and an intelligent agenda program into the memory, wherein the intelligent agenda program is adapted to interface with the presentation program and to respond to a second plurality of user inputs to a graphical user interface of the configuration program;	[0036], lines 3-18
responsive to a user invoking an options menu on the presentation program and selecting an intelligent agenda option on the menu, creating the intelligent agenda by accessing a plurality of titles from the plurality of slides in the presentation program to create an outline, adapting the outline to be displayed in a corner on each of the plurality of slides, and further adapting the outline to track a user's progression through a presentation of the plurality of slides by a pointer that automatically moves to a title in the outline corresponding to a currently displayed slide;	FIG. 4; [0039, lines 3-5; FIG. 13A-FIG. 20
further responsive to the user selecting the intelligent agenda option on the menu, displaying the graphical user interface on a display of the computer;	FIG. 11; [0053]
responsive to a first set of user inputs to the graphical user interface, introducing a user configurable line to each slide, the user configurable line connecting to each of two contiguous border lines on each slide to define a corner section containing the outline;	FIG. 4, 312, 314; FIG. 5, 414; FIGS. 13A-20
responsive to a second set of user inputs to the graphical user interface, limiting the number of lines on the outline and causing the user to select either a first display option or a second display option, wherein, when the user selects the first display option, the outline is modified to display only the title in the outline corresponding to the currently displayed slide, a preceding title located immediately before the title, and a following title located immediately after the title, and when the user selects the second display option, the outline is modified to display a third plurality of titles that precede the title subject to a line limitation of the second user input, and then only when the line	[0053], [0054], [0055], FIG. 4, 336; FIG. 11, 474

limitation has not been met, and when the line limitation has not been met, displaying a fourth plurality of titles that follow the title until the line limitation is met.	
responsive to a third user input, limiting a fifth plurality of titles to be displayed in the outline to either the third plurality of titles that precede the title, or to the fourth plurality of titles that follow the title, and without regard to the line limitation.	FIG. 11, 476; FIG. 4, 336, 338

B. Summary of the Examiner's assertion of cited art.

The Examiner asserts that Fullerton teaches presenting the outline data on the display simultaneously with the presentation of the context data (e.g. paragraph 14 and 181), that Fullerton's outline is displayed simultaneously with each slide to provide progress feedback and context information (Fullerton paragraphs 8, 14 and 185), and can be moved around to different areas of the presentation (e.g. in paragraph 180). The Examiner asserts that Dieberger teaches displaying an outline in a corner on the slides (e.g. in figure 1, outline is shown in the upper left corner and in abstract, paragraphs 20-21 and 36.) The Examiner asserts that it would be obvious to one of ordinary skill to modify the presentation of Fullerton to include the outline placement and display for each slide of Dieberger because "it would provide more viewing space for the presentation content, and easily display the contextual information in a non-intrusive manner (e.g. in paragraph 21 and 25 of page2)." Microsoft teaches configuring line border elements displayed in a slide show (figures 5-11). Yacovone teaches creating the outline from the title of each of the slides in the presentation (e.g. paragraph 41, ..."extracts the title for each slide ... and stores each slide title in the database for use later during playback by the view an active table of contents" and figure 6). The Examiner further combines the hierarchal display of Fullerton with Lee, Garder, and Banning to disclose the display options of prior claim 57.

Applicants submit that claims 58 and 59 distinguish over the art of record, individually or in combination, because all of the limitations of claims 58 and 59 are not present in the combined prior art.

C. All of the limitations of claims 58 and 59 are not present in the combined prior art.

All of the limitations of claims 58 and 59 are not present in the combined art because the claim, when read as a whole, requires an interaction of elements that is not disclosed in the cited art, individually or in combination.

1. A computer implemented method for adding an intelligent agenda to a first plurality of slides in presentation program stored in a memory connected to a computer

The preamble of claim 58 recites “[a] computer implemented method for adding an intelligent agenda to a first plurality of slides in presentation program stored in a memory connected to a computer.” The intelligent agenda and the presentation program are cited in the limitations discussed below.

2. loading a configuration program and an intelligent agenda program into the memory, wherein the intelligent agenda program is adapted to interface with the presentation program and to respond to a second plurality of user inputs to a graphical user interface of the configuration program

Claim 58 recites “loading a configuration program and an intelligent agenda program into the memory, wherein the intelligent agenda program is adapted to interface with the presentation program and to respond to a second plurality of user inputs to a graphical user interface of the configuration program.” This element of claim 58 requires an interaction of elements that includes both an interface with a presentation program and a response to a plurality of user inputs to a graphical user interface.

3. responsive to a user invoking an options menu on the presentation program and selecting an intelligent agenda option on the menu, creating the intelligent agenda by accessing a plurality of titles from the plurality of slides in the presentation program to create an outline, adapting the outline to be displayed in a corner on each of the plurality of slides, and further adapting the outline to track a user’s progression through a presentation of the plurality of slides by a pointer that automatically moves to a title in the outline corresponding to a currently displayed slide

Claim 58 recites “responsive to a user invoking an options menu on the presentation program and selecting an intelligent agenda option on the menu, creating the intelligent agenda by accessing a plurality of titles from each of the plurality of slides in the presentation program to create an outline, adapting the outline to be displayed in a corner on each of the plurality of slides, and further adapting the outline to track a user’s progression through a presentation of the plurality of slides by a pointer that automatically moves to a title in the outline corresponding to a currently displayed slide.”

Claim 58 recites “adapting the outline to be displayed in a corner on each of the plurality of slides, and further “adapting the outline to track a user’s progression.” The cited art,

individually or in combination, do not disclose the particular “corner” as defined in claim 58, and the combination of the pointer that automatically moves to a title in the outline corresponding to the currently displayed slide.

Moreover, claim 58 also recites “wherein the outline is created from a title of each of the slides in the presentation” and the outline is displayed “on each of a plurality of slides.” The cited art, individually or in combination, fails to meet an outline displayed “on each of the plurality of slides,” the outline “created by accessing a plurality of titles from a plurality of slides” at least because the cited portions of Yacovone are silent to these limitations. While Yacovone teaches “storing each slide title in a database for use later ... in the form of an active table-of-contents,” the cited portions of Yacovone are silent as to displaying its active table-of-contents on each slide. Moreover, Yacovone states that the “table of contents is selectable by the view and allows the viewer to navigate from slide to slide at anytime during playback of the presentation.” ([0041]. Claim 58’s outline is adapted to show the location in the outline of the currently viewed slide, and not to provide a navigation tool to be used by the viewer to navigate through the slides. Rather the pointer shows the view where the currently displayed slide is in the outline. The cited portions of Dieberger are not relied upon and do not remedy this deficiency. Hence, the claim’s limitations of “wherein the outline is created from a plurality of titles from the plurality of slides” are outside the scope of the cited art.

4. further responsive to the user selecting the intelligent agenda option on the menu, displaying the graphical user interface on a display of the computer;

Claim 58 recites “further responsive to the user selecting the intelligent agenda option on the menu, displaying the graphical user interface on a display of the computer.” The cited art, individually or in combination, are silent as to an intelligent agenda option on the menu. Moreover, the cited art, individually or in combination, is silent as to displaying a graphical user interface in response to a user selection.

5. responsive to a first set of user inputs to the graphical user interface, introducing a user configurable line to each slide, the user configurable line connecting to each of two contiguous border lines on each slide to define a corner section containing the outline

Claim 58 recites “responsive to a first set of user inputs to the graphical user interface, introducing a user configurable line to each slide, the user configurable line connecting to each of two contiguous border lines on each slide to define a corner section containing the outline.”

The Examiner previously alleged that Fullerton taught “displaying an outline” (Office Action p.3 (citing to Fullerton [0014])), and that Dieberger taught “in a corner on each of a plurality of slides” (Office Action p. 6 (citing to Dieberger FIG. 1 and [0020]-[0021] and [0036])). The Examiner states, in regard to a motivation to combine the references, that the modification “would provide more viewing space for the presentation content, and easily display the contextual information in a non-intrusive manner (e.g. in paragraph 21 and 25 of page 2).” (Office Action, page 6).

Claim 58 is different from the art cited by the Examiner, individually or in combination, because claim 58 recites a specific configuration of the line defining the “corner” which is not taught by the prior art. Moreover, the claim must be read as a whole, and the border is created in conjunction with the user’s inputs to the graphical user interface and contains the outline made into an intelligent agenda by the intelligent agenda programs interface with the slides of the presentation program.

Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Applicants respectfully disagree with the Examiner’s reasoning because displaying an outline on the slides of Fullerton would be duplicative and render Fullerton’s outline window unsatisfactory for its intended purpose.

The combination proposed by the Examiner would place an outline onto the slides displayed in Fullerton’s main window 232, but Fullerton already displays an outline in outline window 238. As such, the combination would needlessly duplicate the outline information, displaying them both on the slides of main window 232 and on outline window 238. With such duplication of information, Fullerton’s outline window becomes unsatisfactory for its primary purpose of displaying outline information because it would then be merely be duplicating information already found on the slide, per the proposed combination. As such, duplicating the outline information renders Fullerton’s outline window 238 unsatisfactory for its primary purpose. Hence, there is not sufficient motivation for the proposed combination.

6. responsive to a second set of user inputs to the graphical user interface, limiting the number of lines on the outline and causing the user to select either a first display option or a second display option, wherein, when the user selects the first display option, the outline is modified to display only the title in the outline corresponding to the currently displayed slide, a preceding title located immediately before the title, and a following title located immediately after the title, and when the user selects the second display option, the outline is modified to display a third plurality of titles that precede the title subject to a line limitation of the second user input, and then only when the line limitation has not been met, and when the line limitation has not been met, displaying a fourth plurality of titles that follow the title until the line limitation is met.

Claim 58 recites “responsive to a second set of user inputs to the graphical user interface, limiting the number of lines on the outline and causing the user to select either a first display option or a second display option, wherein, when the user selects the first display option, the outline is modified to display only the title in the outline corresponding to the currently displayed slide, a preceding title located immediately before the title, and a following title located immediately after the title, and when the user selects the second display option, the outline is modified to display a third plurality of titles that precede the title subject to a line limitation of the second user input, and then only when the line limitation has not been met, and when the line limitation has not been met, displaying a fourth plurality of titles that follow the title until the line limitation is met.”

The combination of cited fails to teach “responsive to a user limiting the number of lines on the outline, displaying the limited number of lines on the outline,” wherein the outline is displayed on each of a plurality of slides of a presentation, because resizing a box does not display a limited number of lines on an outline on each slide of a presentation. For example, a user may resize a box so that two lines of text are displayed and then reduce the font size of the text in the box by half so that four lines would then be displayed. As such, since the user did not limit the number of lines displayed by the box and instead merely changed the size of the box, the number of lines displayed in the box changed. Hence, merely resizing a box does not inherently disclose limiting the number of lines displayed by the box. Stated another way, while resizing a box may limit the display area of a box, resizing a box does not limit the number of lines displayed by the box.

7. responsive to a third user input, limiting a fifth plurality of titles to be displayed in the outline to either the third plurality of titles that precede the title, or to the fourth plurality of titles that follow the title, and without regard to the line limitation

Claim 59 depends from claim 58 and recites “responsive to a third user input, limiting a fifth plurality of titles to be displayed in the outline to either the third plurality of titles that precede the title, or to the fourth plurality of titles that follow the title, and without regard to the line limitation.” Claim 59 is different from the cited art for the reasons set forth above.

D. An explicit analysis must be provided in an obviousness rejection

In combining references, an explicit analysis is required to combine or modify references. The Supreme Court has stated the following:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness .). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l v. Teleflex Inc. 500 U.S.____, 2007 U.S. LEXIS 4745, (2007) at 14 (2007). Conclusory statements are insufficient to support obviousness rejections. In particular, “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The Examiner asserts that it would be obvious to one of ordinary skill to modify the presentation of Fullerton to include the outline placement and display for each slide of Dieberger because “it would provide more viewing space for the presentation content, and easily display the contextual information in a non-intrusive manner (e.g. in paragraph 21 and 25 of page2).

As can be seen, an express analysis has not been provided in the Examiner’s reasons for combining the references. The statements made by the Examiner do not provide reasons as required in the Supreme Court guidance on combining references in the KSR case. Instead, the

Examiner has only provided statements that are conclusory or reciting some desired goal. These conclusions and desired goals have not been supported with any explicit analysis or articulated reasoning with some rationale underpinnings to support the conclusions or goals for combining the elements in these two references in the manner proposed by the Examiner. Further, even if these conclusory statements or goals could be considered "reasons", they do not have any articulated reasoning with some rational underpinning to support the examiners assertion of obviousness.

The Examiner has merely offered a goal or desire to "provide more viewing space for the presentation content, and easily display the contextual information in a non-intrusive manner". To meet this goal, the Examiner states it would have been obvious to combine Fullerton and Dieberger. Nowhere, however, has the Examiner gone beyond this conclusion or desired goal to explain sufficiently why one of ordinary skill in the art would have combined these two references.

Therefore, the rejection of claim 57 under 35 U.S.C. § 103 has been overcome.

III. Objection to Claims

The Examiner has stated that claim 57 is objected to because of a number of informalities. Claim 57 has been canceled, and therefore, the objections are moot.

IV. Conclusion

It is respectfully urged that the subject application is patentable over Fullerton, Dieberger, Yacovone, Lee, Gardner and Banning and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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